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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,064	06/28/2001	Rabindranath Dutta	AUS920010467US1	5457

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EXAMINER
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RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/894,064

**Applicant(s)**

DUTTA ET AL.

**Examiner**

Rob Rhode

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant amendment of 11/9/04 amended claims 1, 10, 19, 20, 21, 22, 24 - 27, 32 - 40, 45 and 46 as well as traversed rejections of Claims 1 - 46.

Currently, claims 1- 46 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 –4, 6 – 13, 15 – 22, 28 – 36 and 40 - 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (US 2001/0044787 A1) and Resneck (US 2002/0002545 A1).**

Regarding claim 1 and related claims 10, 19, 20, 32, 33 and 46, Schwartz teaches a method and system for effecting a transaction between a user and an enterprise wherein said user incurs an obligation to said enterprise, said transaction being authorized based on an anonymous email address (Abstract, Para 0039 and Para 0069 and Figure 2 and 3), said method comprising:

While Schwartz does disclose effecting anonymous transactions via anonymous email with a portable device and guarantees the credit of the user as well as back office systems, the reference does not specifically disclose and teach issuing a portable processing device/smart card to said user, said portable processing device/smart card including input and output means, processing means and memory means, said portable processing device/smart card being selectively operable for processing information related to said transaction; storing said anonymous email address in said memory means; programming said portable device/smart card with predetermined conditions related to use of said portable device/smart card in effecting said transaction; and interfacing an enterprise computing system with said portable device when said user incurs an obligation using said portable device, said anonymous email address being accessible by said enterprise computing system for enabling anonymous communication between said enterprise computing system and a quantor of said transaction.

On the other hand, Resneck discloses and teaches a method and system for issuing a portable processing device/smart card to said user, said portable processing device/smart card including input and output means, processing means and memory means, said portable processing device/smart card being selectively operable for processing information related to said transaction (see at least Abstract and Figure 1); storing said account access information/anonymous email address in said memory means (Para 0006);

programming said portable device/smart card with predetermined conditions related to use of said portable device/smart card in effecting said transaction (see at least, Para 0007); and

interfacing an enterprise computing system with said portable device when said user incurs an obligation using said portable device, said account access information anonymous email address being accessible by said enterprise computing system for enabling anonymous communication between said enterprise computing system and a quantor of said transaction. (see at least Para 0009, Para 0029 and Figure 2). Please note that Resneck does not specifically disclose anonymous email address being employed. However, Resneck does disclose transmitting the anonymous account access information for a transaction, which one of ordinary skill would understand contains both a destination and access. Moreover, Schwartz discloses anonymous email for a transaction.

Thereby, it would have been obvious to one of ordinary skill in the art to have provided the method and system of Schwartz with a method and system of Resneck to have enabled a method and system for effecting a transaction between a user and an enterprise wherein said user incurs an obligation to said enterprise, said transaction being authorized based on an anonymous email address, said method comprising: issuing a portable processing device/smart card to said user, said portable processing device/smart card including input and output means, processing means and memory means, said portable processing device/smart card being selectively operable for

Art Unit: 3625

processing information related to said transaction; storing said anonymous email address in said memory means; programming said portable device/smart card with predetermined conditions related to use of said portable device/smart card in effecting said transaction; and interfacing an enterprise computing system with said portable device when said user incurs an obligation using said portable device, said anonymous email address being accessible by said enterprise computing system for enabling anonymous communication between said enterprise computing system and a quantor of said transaction – in order a smart card transmit an access code as both a destination and access code for enabling an in-store transaction. Schwartz discloses a method and system for effecting a transaction between a user and an enterprise wherein said user incurs an obligation to said enterprise, said transaction being authorized based on an anonymous email address (Abstract, Para 0039 and Para 0069). Resneck discloses a method and system for issuing a portable processing device/smart card to said user, said portable processing device/smart card including input and output means, processing means and memory means, said portable processing device/smart card being selectively operable for processing information related to said transaction; storing said anonymous email address in said memory means; programming said portable device/smart card with predetermined conditions related to use of said portable device/smart card in effecting said transaction; and interfacing an enterprise computing system with said portable device when said user incurs an obligation using said portable device, said anonymous email address being accessible by said enterprise computing system for enabling anonymous communication between said enterprise computing

system and a quantor of said transaction (see at least Para 0009, Para 0029 and Figures 1 and 2). In this manner, the portable device/smart card will be much more effective and timely in that the email address will serve both as an address as well as an access code, which is anonymous and thereby protects the sensitive account information of the user. Moreover, the identify information of the user is protected as well, which will further increase the user's trust in this method and system.

Regarding claim 2 and related claim 11, Resneck teaches a method, wherein said obligation is incurred for the rendering of services (Abstract).

Regarding claim 3 and related claims 12, Resneck teaches a method, wherein said obligation comprises a payment for receipt of goods (Page 2, Para 0029).

Regarding claim 4 and related claims 13, 31 and 44, Shwartz teaches a method, wherein said enterprise is a rental enterprise engaged in renting items to users and (5 and 14) wherein said rental enterprise is a media rental enterprise engaged in renting media items to users for limited periods of time, said obligation comprising a commitment to return said media items by a predetermined time (see at least Abstract). Please note that Shwartz discloses an ecommerce site, which certainly could have been a rental enterprise. Moreover, these rental enterprises were old and well known at the time of the invention, which would have included the charge for the rental - the requirement to return the item within a predetermined timeframe.

Regarding claim 6 and related claims 15, 30 and 43, the recitation "wherein said enterprise is a library, said obligation comprising a promise to return items borrowed from said library", such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "enterprise" already disclosed by Shwartz and Leason.

Regarding claim 7 and related claims 16 and 17, Shwartz teaches a method further including: maintaining a database by said guarantor, said database containing information identifying value of items dispensed to said user from said enterprise, said obligation comprising a commitment to return or pay for said items by a predetermined time (Page 2, Para 0021, Page 3, Para 0048 as well as Page 5, Para 0098). Please note that in online methods and systems, which has a database for storing information/data such specifics as "identifying value of items" and associated information/data is given little patentable weight. The phrase(s) and or word(s) are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant's invention from Schwartz. Thereby, the non-fictional descriptive material is directed only to the content of the data, which is stored data and does not affect either the structure or method/process Schwartz, which leaves the method and system unchanged.



Regarding claim 8 and related claim 36, Shwartz teaches a method and further including: maintaining a current account of said items, said current account including an initial value balance funded by said user less said replacement value for items currently held by said user (Page 2, Para 0029 & 30 as well as Page, Para 0098).

Regarding claim 9, and related claims 18 and 45, Shwartz teaches a method, wherein said user is enabled to incur said obligation to said enterprise based only on said email address without a disclosure of an identity of said user to said entity (Abstract, Page 3, Para 0039 and Page 4, Para 0069).

Regarding claim 21 and related claim 34, Schwartz teaches a method wherein said storing is accomplished by said quantor of said transaction (0023).

Regarding claim 22 and related claim 35, Resneck teaches a method, wherein said interfacing is accomplished by connecting said smart card to an enterprise server system, said enterprise system server being enabled for maintaining an inventory database containing a listing of items available for dispensing in exchange for said obligation (Para 0037 and 0038). Please note that Resneck does specifically disclose an inventory system. However, Resneck does disclose an enterprise system, which is old and well known that these systems supporting merchant's or other business enterprises had and do have inventory capability. In that regard, it would have been obvious to have provided the method and system of Resneck with an inventory system

to have enabled an enterprise server to maintain an inventory database, which can also can transmit inventory information status as well.

Regarding claim 28 and related claim 41, Shwartz teaches a method wherein said obligation is guaranteed by a guarantor separate from said user and said enterprise (Abstract) and (29 and 42) further including notifying said guarantor by said enterprise computing system when said obligation is not fulfilled (Page 3, Para 0046).

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 23 - 24 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shwartz (US 2001/0044787 A1) and Resneck (US 2002/0002545 A1) and further in view of Webb (US 2002/0143564 B1).**

The combination of Shwartz and Resneck discloses and teaches substantially the applicant's invention.

Although the combination does disclose back office infrastructure, the references do not specifically disclose and teach a method, wherein said enterprise server system is further enabled for maintaining a balance of said items available after deducting items dispensed and currently in possession of said user; wherein said inventory server system is further selectively operable for transmitting an identity of said items dispensed to said smart card of said user; and wherein said portable device is enabled to maintain in said memory means of said portable device/smart card, a listing of said items dispensed as well as wherein said inventory server is further enabled to maintain a record of value of said items dispensed to said user.

In the same area of server with inventory information/data and regarding claims 23 and 24 Webb teaches a method, wherein said enterprise server system is further enabled for maintaining a balance of said items available after deducting items dispensed and currently in possession of said user (Para 0035) as well as (24) wherein said inventory server system is further selectively operable for transmitting an identity of said items dispensed to said smart card of said user (Para 0023). Please note that Webb does not specifically disclose a smart card. However, Webb does disclose portable devices. Moreover, Resneck disclosed a portable device such as a smart card, which has storage capability. In that regard it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided Webb with another portable device such as a smart card. In this manner, the portable devices can include a smart card, which fits more comfortably in a personal carrying device such as a purse.

Regarding claim 39, Webb teaches a medium wherein said inventory server system is further enabled to maintain a record of value of said items dispensed to said user (Figure 8)

It would have been obvious to one of ordinary skill at the time of the invention to have provided the combination of Shwartz and Resneck with the method and system of Webb to have enabled a method, wherein said portable device is enabled to maintain in said memory means of said portable device/smart card, a listing of said items dispensed and wherein said inventory server is further enabled to maintain a record of value of said items dispensed to said user – in order to provide the necessary inventory status. The combination of Schwartz and Resneck discloses a method and system for guaranteeing a transaction by issuing an anonymous email address from a guarantor, which is able to incur obligations and keep track of subsequent transactions. Webb discloses wherein said portable device is enabled to maintain in said memory means of said portable device/smart card, a listing of said items dispensed ( ) and (26) wherein said inventory server is further enabled to maintain a record of value of said items dispensed to said user (Abstract and Figure 8). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Shwartz and Resneck with a method and system wherein said portable device is enabled to maintain in said memory means of said portable device/smart card, a listing of said items dispensed ( ) and (26) wherein said inventory server is further enabled to maintain a record of value of said

Art Unit: 3625

items dispensed to said user. In that regard, it will relieve the customer of having to remember these items, which will save them time and thereby improve customer satisfaction. Moreover, the increased satisfaction with this site will increase the probability that they will recommend the site to others.

**Claims 25 – 27 and 37 – 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Schwartz, Resneck and Webb as applied to claim 24 above, and further in view of Hartwig (US 2002/0082925 A1).**

The combination of Schwartz, Resneck and Webb substantially disclose the applicant's invention.

However, the combination does not specifically disclose and teach a method wherein said portable device is enabled to maintain in said memory means of said portable device/smart card, a listing of said items dispensed and wherein said inventory server is further enabled to maintain a record of value of said items dispensed to said user

On the other hand and regarding claim 25 and related claims 26, 27, 37, 38 and 40 Hartwig teaches a method, wherein said portable device is enabled to maintain in said memory means of said portable device/smart card, a listing of said items dispensed (Para 0031) and wherein said inventory server is further enabled to maintain a record of

Art Unit: 3625

value of said items dispensed to said user and to store on users portable device/smart card (Para 0028 and 0040).

It would have been obvious to one of ordinary skill to have provided the combination of Schwartz, Resneck and Webb with the method of Hartwig to have enabled a method wherein said portable device is enabled to maintain in said memory means of said portable device/smart card, a listing of said items dispensed and wherein said inventory server is further enabled to maintain a record of value of said items dispensed to said user – in order to track and retain items already dispensed. The combination of Schwartz, Resneck and Webb disclose a method guaranteeing a transaction between a user and an enterprise, which uses a portable device such as smart card as well inventory of items purchased. Hartwig discloses a method wherein said portable device is enabled to maintain in said memory means of said portable device/smart card, a listing of said items dispensed and wherein said inventory server is further enabled to maintain a record of value of said items dispensed to said user (Para 0028, 0036 and 0040). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Schwartz, Resneck and Webb with a method wherein said portable device is enabled to maintain in said memory means of said portable device/smart card, a listing of said items dispensed and wherein said inventory server is further enabled to maintain a record of value of said items dispensed to said user.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 - 46 have been considered but are moot in view of the new ground(s) of rejection based on new prior art.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

Art Unit: 3625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

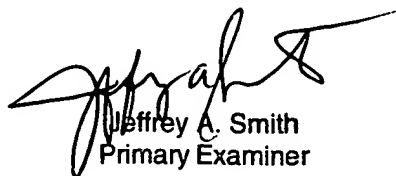
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RER

  
Jeffrey A. Smith  
Primary Examiner